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Docket No.: 2641/207-168

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By: Morganz Nally

Date: August 4, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

Applicant : Friedhelm Beckmann

Applic. No. : 09/666,951

Filed : September 20, 2000

Title : Hollow Section with Internal Reinforcement and  
Method of Producing the Hollow Section

Examiner : Shalie A. Manlove - Art Unit: 1755

### REPLY BRIEF

Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

S i r :

This is a *Reply Brief* responding to the *Examiner's Answer*  
dated and mailed June 2, 2003.

## Arguments for traversing the enablement rejection

In the paragraph bridging pages 5 and 6 of the *Examiner's Answer*, the Examiner stated that:

The activatable foamable material is not clearly taught so that one of ordinary skill in the art would recognize what substance appellant considers as the invention. Specific materials are neither identified in the specification nor claimed. One of ordinary skill in the art can not read appellant's preferred embodiment into the claims thus, it can not be assumed that the activatable foamable material is limited to those known to be used in the automotive industry. There is nothing on the record to indicate that any known activatable foamable material can be used in the claimed hollow section thus, one of ordinary skill in the art cannot make this assumption. Accordingly, one of ordinary skill is given no guidance as to what substance appellant considers being activatable foamable material.

The enablement requirement is discussed in great detail in MPEP § 2164 pages 178-193 (8th edition, first revision). The test for enablement is set forth in MPEP § 2164.01, which states:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: **is the experimentation needed to practice the invention undue or unreasonable?** That standard is still the one to be applied.

(Emphasis added)

According to MPEP § 2164.01:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The Examiner has applied not one of the above-identified factors in the enablement rejection. The Examiner is correct that no "specific materials" of "activatable foamable material" are identified or disclosed in the instant application. Notwithstanding, it is believed that a person skilled in the art would know what is understood by "activatable foamable material" and, therefore, no undue or unreasonable experimentation is believed to be required to enable one skilled in the pertinent art to make and use the claimed invention. For example, as stated by the Examiner in the *Examiner's Answer* on page 5, lines 1-2, "Russel teaches the activatable material to be a mixture of plastic materials and reinforcing fibers (page 1, lines 34-39)". *Russel* discloses the plastic materials and reinforcing fibers used in considerable detail. A person skilled in the art must

merely read *Russel* for a detailed description of "activatable foamable material" used in the same field of technology as the present invention.

According to MPEP § 2164.04, the Examiner has the burden to establish a reasonable basis to question the enablement provided for the claimed invention. The Examiner stated that "[t]here is nothing on the record to indicate that any known activatable foamable material can be used in the claimed hollow section thus, one of ordinary skill in the art cannot make this assumption." How does the Examiner know that one of ordinary skill in the art cannot make this assumption? Instead of offering factual evidence, the Examiner made a statement without any factual support or Official Notice. The Examiner cannot simply be the devil's advocate postulating "lack of enablement" that may or may not be correct and leave it up to Appellant to show or prove the contrary.

The Examiner further stated that:

Appellant's argument with respect to 112, second paragraph, rejection is that *Ex Parte Slob* is not cited in the MPEP. Appellant's apparent position is that the only case law that can be cited is that codified in the MPEP. It appears to be Appellant's position that *Ex Parte Slob* is not case law since it is not cited in the MPEP. The Appellant's position is incorrect especially since any case that is cited in the USPQ and which has not been overturned by a court of law is valid case law. *Ex Parte Slob* has not been

overturned. The case law cited by Appellant is irrelevant since it only addresses 35 U.S.C. 112, first paragraph written description requirement, and not the rejection at hand.

Appellant never questioned whether or not *Ex Parte Slob* is proper and applicable case law; however, Appellant questioned the precedential value of *Ex Parte Slob* since *Ex Parte Slob* is an old Board of Appeals decision not mentioned in the detailed discussion of "enablement" in the MPEP. Appellant stated in the *Brief on Appeal* that "Appellant believes that the [current] US PTO's interpretation and position on statutory law and case law is codified or summarized in the MPEP. Hence, it may be more efficient to start the discussion with the review of the relevant and applicable MPEP provisions."

Examiner's Arguments in the *Examiner's Answer* with respect to the prior art rejections are basically repetition of previous arguments brought forward, and therefore, raise no new issues. Consequently, in order to expedite the appeal procedure, Appellant respectfully directs the honorable Board to the arguments and facts discussed in the *Brief on Appeal*.

The honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

Respectfully submitted,

  
For Appellants

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